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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,605	09/27/2001	Edgar Pau	007051.P015 (18265US01)	4654

23446 7590 01/24/2008
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EXAMINER

THOMASSON, MEAGAN J

ART UNIT	PAPER NUMBER
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3714

MAIL DATE	DELIVERY MODE
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01/24/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 09/965,605	Applicant(s) PAU ET AL.	
	Examiner Meagan Thomasson	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office Action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 31, 2007 has been entered.

Response to Amendment

The examiner acknowledges the amendments made to claims 1,14,17 and 20-22. Claims 5 and 23 are canceled; claims 1-4 and 6-22 are pending in this application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-13,17,18 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baerlocher (US 6,776,711 B1) in view of Baerlocher et al. (US 6,569,015 B1); herein referred to as Baerlocher '711 and Baerlocher '015, respectively.

Regarding claim 1,17,20,21 Baerlocher '711 discloses a gaming machine comprising a display and a game controller arranged to control images displayed on the display, the game controller being arranged to play an underlying game wherein one or more random events are caused to be displayed on the display and, if a predefined winning event occurs, the machine awards a prize (i.e. Baerlocher '711 discloses a slot machine, col. 1-2). Further, Baerlocher '711 discloses upon the occurrence of a predefined triggering event, prior to the machine awarding the prize, the player is offered a choice of two or more different prize sets, from which the player is allowed to choose only one prize set (col. 3, lines 35-40; a player selects the "Pick" button to choose a prize set). Each prize set contains a plurality of prize outcomes, including non-winning prize outcomes ("bonus terminators"; col. 7, lines 35-42). From the selected prize set a prize is drawn (col. 4, lines 1-8), and wherein each prize sets has the same number of potential outcomes from which prize sets a prize is to be drawn and awarded to the player (Fig. 6, [56a] and [58a]; col. 7, line 55). The prize outcomes of each prize

set are independent of any prize awarded in the underlying game on the occurrence of a predefined triggering event (prizes may be an award of base game credits independent of base game winnings; col. 7, lines 24-25), and wherein at least one of the prize sets display at least two different winning outcomes (Fig. 6, [56a] and [58a]), and wherein the total theoretical return to the player is the same regardless of the prize set the player chooses (Col. 8, lines 1-2, "for each level, sets containing roughly the same average values and risk level").

Further, the prize sets of Baerlocher '711 have different volatilities based on a distribution of winning and non-winning outcomes and prize amounts in each of the different prize sets. As shown in Fig. 3, the level 3 prize sets have different volatilities as the first award set shown has prizes ranging from a minimum amount of 10 to a maximum amount of 25, and the second award set shown has prizes ranging from a minimum amount of 12 to a maximum amount of 22. As a result, the first award set is more "volatile" than the second award set because the range of possible prizes is much greater.

Baerlocher '711 does not specifically disclose that all of the prize outcomes of each prize set are displayed to the player prior to the player selecting a prize set. Col. 3, lines 59-63 of Baerlocher '711 disclose that upon player selection of a pick button, one of the award groups is assigned to each pick button. However, in an analogous slot machine bonus round invention, Baerlocher '015 discloses allowing a player to choose a prize set (i.e. the player may choose "Value" or "Multiplier"), wherein the prize sets display all of the prize outcomes, in their entirety, to the player prior to the player

selecting a prize set (Fig. 2, [104] wherein "Bonus Scheme Selects and Displays A Value, Multiplier, and Offer", prior to player selection step [106]). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention disclosed by Baerlocher '711 with the teachings of Baerlocher '015 (i.e. a bonus round wherein the prizes of a prize set are displayed to a player prior to a player selection), as the inventions are analogous in that they both disclose a bonus game featuring player-selectable prize sets wherein a prize contained in the selected prize set is randomly chosen and awarded to a player. One would have been motivated to do so in order to provide a player with a greater feeling of control over the bonus outcome that is to be awarded to the player. Further, Baerlocher '711 states that "the game can award the prize in a plurality of ways" (col. 10, line 56), including that "The game can increase player enjoyment and excitement by disclosing the existence of an additional prize or even the value of an additional prize up front. The knowledge of such a potential prize increases excitement and enjoyment as the player selects a pick button and waits to learn the player's fate" (col. 10, line 53 – col. 11, line 4).

Regarding claim 2, Baerlocher '711 discloses one prize set contains one or more prize outcomes which may be identical to prize outcomes in a different prize set, in Fig. 6; wherein both prize sets 56a and 58a contain the prize outcome "5".

Regarding claim 3, Baerlocher '711 does not specifically disclose one prize set contains one or more prize outcomes which are identical to one or more other prize outcomes in that one prize set. However, Baerlocher '711 discloses the ability of the implementor to structure the awards in the set (col. 7, line 45), and that "the values of

the awards are for illustration purposes, and that the game can employ any desired values" (col. 7, lines 60-62). Thus, it would have been obvious to one of ordinary skill in the art to include prize outcomes that are identical to prize outcomes in another award set.

Regarding claim 4, Baerlocher '711 discloses one or more of the prize sets contains non-winning prize outcomes (Bonus Terminators, as described above).

Regarding claim 6, Baerlocher '711 discloses the predefined triggering event is an occurrence of a special combination during the underlying game (col. 6, lines 54-65).

Regarding claim 7, Baerlocher '711 discloses the predefined triggering event is triggered at random, as symbol combinations are determined randomly.

Regarding claim 8, Baerlocher '711 discloses the underlying game may "incorporate any game such as slot, poker, or keno" (col. 5, lines 20-21).

Regarding claim 9, Baerlocher '711 discloses that the prizes are presented such that the awards may "rotate within a confined area (e.g. the star)" (col. 9, lines 48-52), as shown in Fig. 6, prior to awarding the player with the designated prize. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to present the prizes on segments of wheels that can spin or simulate spinning before stopping randomly on a segment which defines the prize outcome won by the player.

Regarding claims 10,11,18 Baerlocher '711 does not specifically disclose presenting the sets of prizes on three dimensional objects or simulations thereof defining faces which the sets of prizes being presented on the faces of those objects are arranged to spin or turn to simulate spinning or turning before stopping to show or

indicate a face of the object which defines the prize won by the player. However, Baerlocher '711 does disclose the use of two-dimensional display objects in order to display the prizes of a prize set to a player (stars of Fig. 6). It would have been obvious to one of ordinary skill in the art to present the prizes in three-dimensional objects, (e.g. dice) as this is merely a design choice at the discretion of the implementor, and does not provide any new, novel, or unobvious feature to the invention as it does not provide any new or unobvious outcome to the bonus game.

Regarding claim 12, Baerlocher '711 does not specifically disclose presenting each prize set differently. However, this is again a design choice at the discretion of the inventor and does not provide any new or unobvious outcome to the bonus game. Thus, it would have been obvious to one of ordinary skill in the art to present each prize differently.

Regarding claim 13, Baerlocher '711 does not specifically disclose the sets of prizes are presented on representations of board games with the player choosing which board they wish to play and wherein a random selection indicates the number of squares around the selected board that the player will move with the square on which the player lands being the square that defines the prize outcome. However, this is again merely a design choice as to the method of presentation for the bonus game, and does not alter the bonus game outcome. Thus, the use of board game embodiments would have been obvious to one of ordinary skill in the art at the time of the invention.

Regarding claim 21, in addition to the invention disclosed above, Baerlocher '711 discloses that none of the prize sets include a losing outcome which results in the loss

of any prize awarded in the underlying game or a stake wagered on the underlying game. Instead, the "Bonus Terminators" only end the bonus round, and do not affect previous winnings (col. 7, lines 34-36).

Regarding claims 22 and 23, in addition to the invention described above, Baerlocher '711 discloses that the volatility of at least two of the prize sets differ from each other in that the first 2 levels of prize sets in the bonus game may not contain "Bonus Terminator" symbols, and are thus less volatile than prize sets in subsequent levels of the bonus game (Fig. 8).

Claims 14-16,19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baerlocher (US 6,776,711 B1), Baerlocher et al. (US 6,569,015 B1), and further in view of Baerlocher et al. (US 5,788,573); herein referred to as Baerlocher '711, Baerlocher '015 and Baerlocher '573, respectively.

Regarding claim 14, Baerlocher '711/'015 discloses the invention as described above (see claims 1 and 9). Baerlocher '711/'015 does not specifically disclose that the selected wheel is enlarged relative to any non-selected wheels. However, Baerlocher '711 does disclose enlarging the randomly drawn prize from the selected prize set for display to the player (Fig. 7). In a similar bonus game invention, Baerlocher '573 discloses a bonus game comprising a plurality of wheels, wherein the wheel currently being spun is enlarged relative to any non-spinning wheels (Fig. 4). Thus, it would have been obvious to one of ordinary skill in the art to provide a feature wherein the selected wheel is enlarged relative to any non-selected wheels. One would be motivated to do so

in order to visually distinguish the player-selected wheel from the non-selected wheel, just as Baerlocher '711 discloses enlarging prizes to distinguish the drawn prize from the non-drawn prizes.

Regarding claim 15, Baerlocher '711 discloses one prize set contains one or more prize outcomes which may be identical to prize outcomes in a different prize set, in Fig. 6; wherein both prize sets 56a and 58a contain the prize outcome "5".

Regarding claim 16, Baerlocher '711 does not specifically disclose one prize set contains one or more prize outcomes which are identical to one or more other prize outcomes in that one prize set. However, Baerlocher '711 discloses the ability of the implementor to structure the awards in the set (col. 7, line 45), and that "the values of the awards are for illustration purposes, and that the game can employ any desired values" (col. 7, lines 60-62). Thus, it would have been obvious to one of ordinary skill in the art to include prize outcomes that are identical to prize outcomes in another award set.

Regarding claim 19, Baerlocher '711/'015 does not specifically disclose any non-selected wheels disappear from the display when the selected wheel is enlarged. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to include this feature for arguments similar to that of enlarging the selected wheel, in that causing all non-selected wheels to disappear from the screen visually distinguishes the selected element to the player. In a similar manner, Baerlocher '711 discloses causing all non-selected prizes to disappear from the screen (Fig. 7). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to

cause the non-selected wheel to disappear instead of the non-selected prizes, as is currently disclosed by Baerlocher '711.

Response to Arguments

Applicant's arguments filed October 31, 2007 have been fully considered but they are not persuasive.

Specifically, P. 13 of Applicant's remarks state that "In Baerlocher '015, the player may choose to change the value or the multiplier but the player does not know what the new value will be and cannot make a decision based on known information about different prize sets and their volatility. The prize sets are not displayed to the player, and the player has no idea what the prize sets and their possible outcomes are. The player is not shown this set of information and allowed to evaluate it prior to deciding whether to accept the value and multipliers given or change them and gamble on a different result". The Examiner does not find this argument to be persuasive, as the value and multiplier indicators displayed to the player may be reasonably said to comprise "prize sets", as they contain a plurality of potential bonus amounts to be awarded to a player, i.e. a prize.

Further, Baerlocher '015 discloses that "the displays 36 and 38 show the values and multipliers at all times but highlight only the chosen value or multiplier" in col. 8, lines 45-47. That is, the player may view all of the potential outcomes, i.e. all of the possible values and multipliers that they may be awarded, in each prize set prior to the player choosing whether or not to accept the value and multiplier given or change them

and gamble on a different result. Baerlocher '015 describes a play of the bonus game in col. 8, lines 9-29, as follows:

“If the multiplier displayed in initially a relatively high number such as the “X8” in Fig. 4, the player most likely keeps the multiplier and determines whether to change the value or keep the offer. If the value displayed is a relatively low number such as “1” in Fig. 4, the player will probably opt for the chance to obtained a higher value and select the change value button or indicator **44**”.

This passage makes it clear that Baerlocher '015 allows a player to evaluate the prize shown in both the multiplier and value prize sets relative to the other potential prizes in the prize sets in order to evaluate potential risk and reward of keeping or changing their prize. As recited in the above rejection, motivation to combine this feature of displaying all possible outcomes to a player and allowing them to evaluate their options prior to making a prize set selection of Baerlocher '015 can be found in Baerlocher '711, which states that “the game can increase player enjoyment and excitement by disclosing the existence of an additional prize or even the value of an additional prize up front. The knowledge of such a potential prize increases excitement and enjoyment as the player selects a pick button and waits to learn the player's fate” (col. 10, line 66 – col. 11, line 4; emphasis added).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Meagan Thomasson whose telephone number is (571) 272-2080. The examiner can normally be reached on M-F 830-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Meagan Thomasson
January 7, 2008



XUAN M. THAI
SUPERVISORY PATENT EXAMINER